

REMARKS

Claims 42-54 are currently pending, wherein claims 35-41 have been canceled. Applicants respectfully request favorable reconsideration in view of the remarks presented herein below.

In paragraph 5 of the final Office action ("Action"), the Examiner rejects claims 35-54 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shibata et al., Dynamic Hypertext and Knowledge Agent Systems for Multimedia Information Networks, ACM 1993, pages 82-93 ("Shibata") in view of U.S. Patent No. 5, 764,235 to Hunt et al. ("Hunt"), and U.S. Patent No. 5,557,722 to DeRose et al. ("DeRose"). Claims 35-41 have been canceled rendering this rejection moot with regard thereto. Regarding claims 42-54, Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 103(a), the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some motivation to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, the rejection of claims 35-54 under 35 U.S.C. § 103(a) is improper because the Examiner fails to establish a *prima facie* case of obviousness as discussed below.

Independent claim 42 defines a method for formatting a document for presentation on an output device. The method includes, *inter alia*, interrogating the output device to determine a set of capabilities of the output device in response to a

request for the document; generating a style sheet based upon the set of capabilities of the output device determined by interrogating the output device; and formatting the document for presentation on the output device using the style sheet.

In rejecting claim 42, the Examiner asserts that "[I]ndependent claim 42 includes limitations of claim 35, and is rejected under the same rationale except generating the style sheet based upon the set of capabilities of the output device determined by interrogating the output device." In addition, the Examiner concludes that it would have been obvious to one skilled in the art to "have combined Hunt into Shibata and DeRose" because the interrogating allegedly included in the negotiation between server and client would provide the advantage of obtaining a style sheet generated based upon the capabilities of the output device. The Examiner's conclusion is unfounded for the following reasons.

First, nowhere in Shibata, Hunt, or DeRose is there any disclosure or suggestion of *generating* a style sheet based upon a set of capabilities of an output device determined by interrogating the output device in response to a request for a document as claimed. In fact, Shibata and Hunt fail to disclose or suggest the use of a style sheet, much less that the style sheet is *generated* as claimed. Although, DeRose does disclose that the a document may be provided with a style sheet, nowhere in DeRose is there any disclosure or suggestion that the style sheet is *generated* as claimed. Accordingly, the combination of these three references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Shibata, Hunt and DeRose, which Applicants do not concede, the combination

would still fail to render claim 42 unpatentable because the combination fails to disclose or suggest each and every claimed element.

Second, it is unclear from the Examiner's rejection why one skilled in the art would have been motivated to *generate* a style sheet in view of the disclosure in Hunt of negotiating graphical image size between a server and a client. Even if, *arguendo*, the negotiation of Hunt was equivalent to interrogating the output device, one skilled in the art would not have been motivated to *generate* a style sheet in view of the disclosure of Hunt or Shibata. To the contrary, these references merely disclose selecting a predefined or pre-formatted document based on some workstation or transmission attribute, such as image size or data rate. Accordingly, absent proper motivation to combine the cited references, the rejection of claim 42 is improper.

Independent claim 48 defines a method for generating a style sheet used to format a document for presentation on an output device. The method includes, *inter alia*, interrogating the output device to determine a set of capabilities of the output device in response to a request for the document; and based upon the set of capabilities of the output device determined by interrogating the output device, generating a style sheet having a plurality of style definitions for formatting the document for presentation on the output device. Accordingly, independent claim 48 is patentable over the combination of Shibata, Hunt, and DeRose for at least the reason that the combination fails to disclose or suggest *generating* a style sheet based upon the set of capabilities determined by interrogating the output device as claimed. See discussion above with respect to claim 42.

Claims 43-47 and 49-54 variously depend from independent claims 42 and 48. Therefore, claims 43-47 and 49-54 are patentable over the combination of Shibata, Hunt, and DeRose for at least those reasons presented above with respect to claims 42 and 48.

For at least those reasons presented above, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 35-54 under 35 U.S.C. § 103(a).

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny Caudle (Reg. No. 46,607) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: February 26, 2007

Respectfully submitted,

By *Penny Caudle Reg #46,607*
Michael K. Mutter
Registration No.: 29,680
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant